



Attorney Docket No. 3012 P0002

07 RECEIVED  
JUL 21 2003  
TC 1700

PATENT

GP 1745  
#8  
2/23/03  
J. J. J.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: )  
Dr. Braja Mandal and Dr. Robert )  
Filler ) Examiner: Carol Diane Chaney  
Serial No.: 09/879,633 ) Art Unit: 1745  
Filing Date: June 12, 2001 )  
Entitled: )  
Thermal Runaway Inhibitors )

**REPLY TO OFFICE ACTION MAILED 06/18/2003**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

This Reply is submitted in response to the Office Action mailed June 18, 2003 ("Action"), which set a one-month shortened statutory period for response. Because this Reply is submitted within that time limit, no fee is due. However, if any fees are due, you are hereby authorized to debit our Deposit Account No. 23-0280.

**REMARKS**

Claims 1-40 are pending in this Application. In the Action, all the claims were subjected to a restriction requirement, requiring election of one of the following groups of claims:

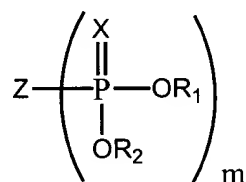
Group I: Claims 1-25, 39 and 40  
Group II: Claim 26  
Group III: Claims 27-33  
Group IV: Claims 34-38

In response, Applicants traverse the restriction requirement, and request that the requirement be withdrawn. The reasons that support the election being made with traverse are detailed in Applicants' Interview Summary of July 02, 2003, which is incorporated by reference and briefly discussed below.

Applicants respectfully submit that it is improper to require restriction to a single disclosed species as defined by a claim that the Examiner has characterized as generic. To illustrate, the Action requires that if Group I is elected for prosecution, then the Applicants must choose a single species defined by claim 4 (Action at pp. 4-6). Prosecution will be restricted to that chosen species if no generic claim – claims 1 through 4 – is allowed (Id. at 6).

Claim 4, a generic claim, recites:

The battery of claim 1 wherein the compound that chemically interferes with flame propagation comprises a compound having the general structure:



wherein X is oxygen or sulfur;

wherein R<sub>1</sub> is selected from the group consisting of (a) C<sub>1</sub> to C<sub>12</sub> alkyl moieties that are terminally substituted with zero to three halogen atoms; (b) C<sub>5</sub> to C<sub>7</sub> aryl groups substituted with zero to four alkyl, haloalkyl, or alkoxy moieties; and (c) trialkylsilyl moieties, wherein the alkyl group has from about 1 to about 6 carbons;

wherein R<sub>2</sub> is selected from the group consisting of (a) C<sub>1</sub> to C<sub>12</sub> alkyl moieties that are terminally substituted with zero to three halogen atoms; (b) C<sub>5</sub> to C<sub>7</sub> aryl groups substituted with zero to four alkyl, haloalkyl, or alkoxy moieties; and (c) trialkylsilyl moieties, wherein the alkyl group has from about 1 to about 6 carbons;

wherein Z is a moiety selected from the group consisting of (a) aryl, aralkylene, arylene, dialkylamino, diarylamino, alkylarylamino, trialkyleneamino, cyclic amino, cyclic amido, cyclic imido, or oxy derivatives thereof; and (b) trialkylalkyleneoxysilane, dialkyldialkyleneoxysilane, alkyltrialkyleneoxysilane, and tetraalkyleneoxysilane; and

wherein m is an integer from 1 to 4.

In accordance with the Action, Applicants provisionally elect Group I for prosecution, as well as the following, single disclosed species:

X is oxygen;

Z is an oxy derivative of an aryl moiety;

R<sub>1</sub> is C<sub>1</sub> to C<sub>12</sub> alkyl moieties that are terminally substituted with zero to three halogen atoms; and

R<sub>2</sub> is C<sub>1</sub> to C<sub>12</sub> alkyl moieties that are terminally substituted with zero to three halogen atoms.

Applicants respectfully make this election with traverse because if claim 4 were allowed, it would be impossible to rewrite claim 4 in dependent form to include all the limitations of the allowed claim (where "X" must be oxygen) such that the other species of claim 4 as originally written are included, particularly where "X" is sulfur. See, e.g., Action at p. 6 (stating that "[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141").

In other words, if claim 4 -- as defined by the above election -- were allowed, then Applicants would have to rewrite an allowed claim for other species to be considered, and which had been recited in the original form of the claim. This is why a generic claim cannot be the same claim that defines a single disclosed species. See, e.g., MPEP § 806.04(d) (stating that a "generic claim cannot include limitations not present in each . . . species claims").

In view of the above election, the Examiner is advised that the following claims read on the elected species: 1-4, 6, 20, 21, 23, 39 and 40.



RECEIVED

JUL 21 2003

TC 1700

CONCLUSION

In sum, if the Examiner makes the restriction requirement final, Applicants provisionally elect with traverse to prosecute the claims of Group I, claims 1-25, 39 and 40. In that event, Applicants request that the remaining claims of Groups II-IV be withdrawn without prejudice.

Date: July 16, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to be "Stephen R. Auten", written over a horizontal line.

By:

Stephen R. Auten  
Reg. No. 47,396  
Wallenstein & Wagner, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, IL 60606  
(312) 554-3300

---

**CERTIFICATION UNDER 37 C.F.R. § 1.10**

Express Mail Label No. EL954222040 US

Date of Deposit: July 16, 2003

I hereby certify that this Reply to the Office Action of June 18, 2003, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service, postage prepaid, under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

A handwritten signature in black ink, appearing to be "Carol J. Wiechers", written over a horizontal line.  
Carol J. Wiechers (178992)